

### REMARKS

#### Interview request

Applicants respectfully request a telephonic interview after the Examiner has reviewed the instant RCE response and amendment. Applicants request the Examiner call Applicants' representative at (858) 720-5133.

#### Status of the Claims

##### *Pending claims*

Claims 1 to 4, 6, 10 to 12, 14 to 17, 47, 48, 74 to 80, 84 to 86, 88, 89, 92, 102 to 108, 112 to 116 and 118 to 175, are pending; claims 74, 108, 112 to 116, 118 to 121 and 147 to 166, are withdrawn. Accordingly, claims 1 to 4, 6, 10 to 12, 14 to 17, 47, 48, 75 to 80, 84 to 86, 88, 89, 92, 102 to 107, 122 to 146 and 167 to 175 are pending and under consideration.

##### *Claims allowed and allowable*

Applicant thank the Examiner for noting claim 3 is allowed and claims 2, 4, 14, 15, 102 to 107, 134, 135 and 143 to 146 would be allowable if rewritten or amended to overcome non-art based rejections.

##### *Claims canceled and added*

Claims 10 to 12, 77 to 80, 84 to 86, 123, 125 to 129, 136, 137 and 167 to 175, are canceled, without prejudice or disclaimer, and new claims 176 to 207 are added. Thus, after entry of the instant amendment, claims 1 to 4, 6, 14 to 17, 47, 48, 74 to 76, 88, 89, 92, 102 to 108, 112 to 116, 118 to 122, 124, 130 to 135, 138 to 166, 176 to 207, will be pending and under consideration.

##### *Restriction Requirement, Election and Rejoining process claims*

In response to the Restriction Requirement mailed May 22, 2003, Applicants elected Group 62, for the genus of nucleic acids having a sequence identity SEQ ID NO:125, vectors, host cells, probes and a method of making the encoded polypeptide (SEQ ID NO:126), with traverse and argument. As noted in their response of February 24, 2004, Applicants respectfully requested that, after the elected product claims have been found to be allowable, all withdrawn process (methods)

claims which depend from or otherwise include all of the limitations of the allowed product claims be rejoined.

#### *Outstanding Rejections*

Claims 1, 2, 4, 6, 10 to 12, 14 to 17, 48, 75 to 80, 84 to 86, 88, 89, 92, 102 to 107, 123 to 128, 131 to 146 and 167 to 175 are rejected under 35 U.S.C. §112, second paragraph. Claims 10 to 12, 17, 75 to 80, 84 to 86, 88, 89, 92, 128, 129, 132, 133, 136 to 142 and 167 to 175 are rejected under 35 U.S.C. §112, first paragraph, written description requirement. Claims 75, 76, 84, 85 and 92 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Tachibana et al. (Database GenBank, US National Library of Medicine (Bethesda, MD, USA), No. D83793, TACHIBANA et al., 01 February 2000) ("Tachibana"). The rejection of claims 88 and 89 under 35 U.S.C. §103(a) as allegedly obvious over Tachibana in view of the state of the art has been maintained.

Applicants respectfully traverse all outstanding objections to the specification and rejection of the claims.

#### Support for Claim Amendments

Support for the new and amended claims can be found throughout the application for the skilled artisan. For example, support for claims directed to polypeptides of the invention lacking a signal sequence, or further comprising a heterologous sequence such as a heterologous signal sequence, can be found, inter alia, in paragraph [0060], page 13, of the specification; which corresponds to paragraph [0060] of U.S. Patent Application Publication serial no. 20030125534 ("the '534 publication"). Support for claims directed to foods, e.g., a dough a baked product or a beverage, or additives, e.g., an enzymatic baking additive, comprising polypeptides of the invention, can be found, inter alia, in paragraphs [0032] and [0051] of the '534 publication. Support for claims directed to milling processes, including dry milling processes and corn wet milling processes, comprising use of polypeptides of the invention, can be found, inter alia, in paragraphs [0008] to [0010] and [0051] of the '534 publication. Support for claims directed to methods of making a fuel ethanol comprising use of polypeptides of the invention, can be found, inter alia, in paragraph [0051] of the '534 publication. Support for claims directed to oilfield processes comprising use of polypeptides of the invention, can be found, inter alia, in paragraphs [0003] and [0051] of the '534

publication. Support for claims directed to feeds comprising polypeptides of the invention, can be found, inter alia, in paragraphs [0003] and [0010] of the '534 publication. Support for claims directed to methods for deinking recycled paper, pulp or fiber comprising polypeptides of the invention, can be found, inter alia, in paragraphs [0051], [0057] and [0085] of the '534 publication, and the claims as filed.

Accordingly, Applicants submit that no new matter is introduced by the present amendments.

Issues under 35 U.S.C. §112, second paragraph

Claims 1, 2, 4, 6, 10 to 12, 14 to 17, 48, 75 to 80, 84 to 86, 88, 89, 92, 102 to 107, 123 to 128, 131 to 146 and 167 to 175 are rejected under 35 U.S.C. §112, second paragraph, for reasons set forth on pages 2 to 6 of the OA. The instant amendment addresses these issues.

Issues under 35 U.S.C. §112, written description requirement

Claims 10 to 12, 17, 75 to 80, 84 to 86, 88, 89, 92, 128, 129, 132, 133, 136 to 142 and 167 to 175, are rejected under 35 U.S.C. §112, first paragraph, written description requirement, for reasons set forth on pages 6 to 11 of the OA. The instant amendment addresses these issues.

Issues under 35 U.S.C. §102(b)

Claims 75, 76, 84, 85 and 92 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Tachibana et al. (Database GenBank, US National Library of Medicine (Bethesda, MD, USA), No. D83793, TACHIBANA et al., 01 February 2000) ("Tachibana"), for reasons set forth on pages 11 to 12, of the OA. The instant amendment addresses these issue.

Issues under 35 U.S.C. §103(a)

The rejection of claims 88 and 89 under 35 U.S.C. §103(a) as allegedly obvious over Tachibana in view of the state of the art has been maintained, for reasons set forth on page 12, of the OA.

As discussed above, the instant amendment removes Tachibana as a single reference teaching each and every element of the claimed invention. The state of the art at the time of the invention does not cure the defect in Tachibana to teach the claimed (amended) sequences.

Accordingly, the rejection of claims 88 and 89 under 35 U.S.C. §103(a) as allegedly obvious over Tachibana in view of the state of the art can be withdrawn.

**CONCLUSION**

In view of the foregoing amendment and remarks, Applicants respectfully aver that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §112, first and second paragraphs, 35 U.S.C. §102(b) and 35 U.S.C. §103(a). In view of the above, claims in this application after entry of the instant amendment are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **564462006100**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone the undersigned at (858) 720-5133.

Dated: August 8, 2007

Respectfully submitted,

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